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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RONALD A. SCHACHAR

Appeal 2009-011866
Application 09/556,143
Technology Center 3700

Before WILLIAM F. PATE, III, JENNIFER D. BAHR, and
JOHN C. KERINS, *Administrative Patent Judges*.

KERINS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Ronald A. Schachar (Appellant) seeks our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 40-59. Claims 1-39 are canceled. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

THE INVENTION

Appellant's invention is directed to a method of operating a laser to treat presbyopia or other ocular conditions. Claim 40, reproduced below, is representative of the claimed subject matter:

> 40. A method of operating a laser to treat one of: presbyopia, hyperopia, primary open angle glaucoma and ocular hypertension, said method comprising the step of:
>
> irradiating a sclera of an eye in a region of a ciliary body to thereby weaken the sclera of the eye and increase an effective working distance of a ciliary muscle of the eye;
>
> wherein irradiating the sclera comprises reducing a thickness of the sclera in the region of the ciliary body without forming an opening completely through the sclera.

THE REJECTION

The Examiner has rejected claims 40-59 under 35 U.S.C. § 102(b) as being anticipated by Wayne F. March, et al., *Safety of High-Energy Neodymium:YAG Laser Pulses in YAG Sclerostomy*, 6 Lasers in Surgery and Medicine, 584-87 (1987) (hereafter, "March").

ISSUE

Has the Examiner established that March discloses a method in which the sclera of an eye is irradiated in a region of the ciliary body, to reduce the thickness of the sclera in that region without forming an opening completely through the sclera?

ANALYSIS

The March publication discloses a sclerostomy process using a pulsed YAG laser for opening a channel through the sclera to form a permanent drainage fistula for drainage of aqueous humor from the interior of the eye. (March 584, Introduction). In addition, March discloses that "a number of previous laser treatments for glaucoma have been advocated and used clinically", and that "none of these previous treatments created a complete scleral perforation or sclerostomy". (March 586, Discussion).

One position maintained by the Examiner is that, because Appellant has employed the open-ended transitional term, "comprising", the claims "include processes which ultimately produce a full scleral perforation", and, as such are anticipated by the March process that produces a complete perforation. (Ans. 5). We agree with Appellant here that this is an improper interpretation of claim 40, which, though reciting the method as "comprising the step of", specifically recites that the irradiation of the sclera is done "without forming an opening completely through the sclera." The Examiner's position here completely disregards or ignores this aspect of the claim.

The Examiner alternatively maintains that, "'[t]he treatment of March after, for example the first 10 shots (i.e. prior to the endpoint of the

treatment) reads on the instant claims.'" (Ans. 5). Supporting this finding, the Examiner maintains that removing a portion of the thickness of the sclera will at least minutely weaken the sclera, which will produce an expansion thereof, which will, in turn, produce some increase in the working distance of the ciliary muscle. (Ans. 7).

While we agree that the Examiner's general finding that removal of material from a structure is logically expected to weaken the structure[1], we again agree with Appellant that the Examiner has not established that "any material removed from any part of an eye" (Reply Br. 5) will have the effect of increasing a working distance of a ciliary muscle of the eye, as claimed. The claims call for the irradiating of the sclera "in a region of a ciliary body", which produces the desired effect, and the Examiner's rejection lacks sufficient findings as to the where the channel or fistula is produced in March.

The third position maintained by the Examiner is that the previous treatments referred to in March, in which a complete scleral perforation or sclerostomy was not achieved, inherently weaken the sclera and increase an effective working distance of the ciliary muscle of the eye. In the Examiner's words, "[i]f all the steps of the method are performed, then any recited result must be produced". (Ans. 5). Appellant counters that "*March* is silent regarding practically all details" of the previous treatments receiving passing mention in March, and that March "never discloses the exact

[1] To the extent that Appellant challenges the rejection on the basis that the Examiner has failed to establish this general principle, we do not find Appellant's arguments to be persuasive.

locations of laser irradiation" in those prior treatments. (Reply Br. 8; App. Br. 16).

While the Examiner maintains that Appellant's originally filed disclosure "provides no guidance as to the exact location of any laser application either, other than it be in the sclera" (Ans. 5-6), the claims consistently recite that the irradiation is "in a region of a ciliary body". If there is some question as to whether this limitation is adequately described in the Specification as filed, or as to whether it is specific enough to enable persons of ordinary skill in the art to make and use the invention, those issues have not been brought before us. As to the alleged anticipation of the claims by the previous treatments mentioned in March, Appellant is correct that March does not identify where the irradiation was performed (other than generally in the sclera), and thus those treatment processes did not necessarily produce the result recited in the claims that the effective working distance of a ciliary muscle of the eye is increased.[2]

The rejection of claims 40-59 as being anticipated by March will not be sustained.

CONCLUSION

The Examiner has not establish that Marsh discloses a method in which the sclera of an eye is irradiated in a region of the ciliary body, to

[2] In this regard, we note that an irradiation of the sclera and removal of a portion of the sclera performed at a location remote from the region of the ciliary body would be expected to weaken the sclera at that location, possibly resulting in localized bulging in response to the intraocular pressure, but such bulging may or may not result in an increase in the effective working distance of the ciliary muscle.

reduce the thickness of the sclera in that region without forming an opening completely through the sclera.

DECISION

The decision of the Examiner to reject claims 40-59 is reversed.

REVERSED

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